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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/006, 999 01/14/98 SHIFF

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/006,999

Filing Date: January 14, 1998

Appellant(s): SHIFF ET AL.

Ann S. Hobbs, Ph.D.
For Appellant

MAILED
JAN 1 2001

EXAMINER'S ANSWER

GROUP 2800

This is in response to appellant's brief on appeal filed 21 December 2000.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 4, 6-8, and 10-12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant groups certain claims together in appellant's arguments. Specifically, arguments for claims 4 and 12 are grouped together. Additionally, arguments for claims 6-8 and 10-11 are argued against by the appellant only on grounds common to those claims and claim 1.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,846,439	BORCHARDT	12-1998
5,866,071	LEU	2-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 6-8, and 10-12 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 13.

(11) *Response to Argument*

In response to appellant's arguments on pages 3-4 that the references fail to show certain features of appellant's invention, it is noted that the features upon which applicant relies (i.e., replaceable tubes, invention "complexity", and the use of 20-30 liters of water) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated on page 3 of the Final Office Action, Leu states that the addition of a media column increases the separation ability of the centrifugation; during centrifugation, analytes are separated into different media according to their densities (column 3, lines 39-40). This clearly contradicts appellant's statement on page 5 that the centrifuge tube of Leu is designed "not for operation during the centrifugation process itself".

In response to appellant's argument that the invention of Leu cannot be bodily combined with the invention of Borschardt, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellant's argument on page 4 that Borschardt teaches away from the use of sand columns, the examiner notes that sand was noted to be poor when used not in centrifugation, but rather in columns, where the flow rate posed a problem. What Borschadt teaches is that the use of sand for separating oocysts was known.

In response to appellant's arguments on pages 6-7 for claims 6-8, note that, as stated above, the use of large volumes of water is not claimed.

In response to appellant's arguments on pages 7-8 for claims 10-11 (apparently erroneously stated as claims 11-12 in the opening sentence of the paragraph), appellant

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supports the examiner's position that the size of the sand might be considered a matter of routine experimentation.

The examiner further notes that the independent claims are Jepson-style claims (See MPEP §2129). Therefore, in claims 1, 10, and 11, the "continuous flow centrifuge apparatus" is impliedly admitted to be old in the art; and in claims 7 and 12, the "method for concentrating, isolating, or detecting a cyst of cryptosporidium or giardia using a continuous flow centrifuge" is impliedly admitted to be old in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MTC
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CKO (conf.) *Christine Dole*
January 4, 2001

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